

REMARKS

The claims have been amended to place them in a format more customary to US patent practice and to address the rejections under 35 USC §112. Thus, withdrawn claims 1-6, (previously "use" claims) have been re-written as process claims of the same category as the examined claims. Thus, they are denoted as "currently amended" instead of withdrawn. It is respectfully requested that the claims be formally rejoined.

Support for new claim 15 can be found, for example, in original claim 13. Support for new claims 16 and 17 can be found, for example, in original claim 6. Support for new claim 18 can be found, for example, in original claim 12. Support for new claim 19 can be found, for example, in original claim 11. Support for new claims 20 and 21 can be found in original claim 3, for example. Support for new claim 22, can be found in original claim 5. Support for new claim 23, can be found in original claim 4. No new matter has been added.

Rejections under 35 USC §103

The claims are rejected under §103 over the prior art discussed in paragraphs 0008-0011 and 0019 of the published application and further in view of Kokai 4-21514.

The Examiner points to paragraphs 0008-0011 of the published application to show that inverted opal like structures prepared from polymer particles are disclosed in the literature. She relies on paragraph 0019 to show that the core/shell particles are known per se. As the Examiner correctly notes on page 3 of the Office Action, the prior art does not show the instant core/shell particles used as templates to make inverse opal structures. The Examiner alleges that "employing the instant core/shell particles would have been obvious as one would expect any known particle to function as a template for an inverse opal".

However, a skilled worker would recognize that the prior art particles were of homogenous chemical composition. The prior art is devoid of any indication that core/shell particles would be suitable as templates for inverted opal like structures. The PTO has not given any rationale for why the prior art should be changed to arrive at the invention or even if it would make common sense to do so. What is it about the prior art knowledge of core/shell particles which would drive such a change? Where is the support for the allegation that "any" particle

would function as a template? Without such support the rejection is baseless.

Moreover, as noted on page 4, lines 17-31 of the specification, the process for the production of inverse opal structures of the present invention has numerous advantages. In particular, large-area regions of high order can be obtained in the template. Furthermore, cracking in the template during drying can be reduced or even prevented entirely and stresses which arise during the drying process can be compensated for by the elastic nature of the shell. Additionally, when polymers form the shell (e.g., claim 4), they can intertwine with one another and mechanically stabilize the regular sphere arrangement in the template. If the shell is strongly bonded to the core (e.g., by grafting an interlayer (claim 23)), the templates can be processed via melt processes. None of these advantages are recognized by the prior art.

Accordingly, there is no obviousness. It is respectfully requested that the rejection under 35 USC 103 be withdrawn

Provisional Double Patenting Rejections

Applicants will address the three provisional rejections once otherwise allowable claims are identified. However, attention is directed to MPEP 804(I)(B)(1). Since the three cited applications were all filed after this application and are not allowed, this application is to be permitted to issue.

The §103 rejection over the two US patents

Both cited US patents are national phases of PCT filings which were published in German-not English. See the attached copies of front pages of WO 03/025035 and WO 03/106557. They are not available as §102(e)/103 prior art. The international filing date of this application is September 3, 2003 which eliminates the potential §102(e)/103 effect of WO 03/106557) (Dec. 24, 2003), the PCT publication corresponding to US 7,291,394. The German priority date claimed in the application (Sept. 30, 2002) also antedates the publication date of WO 03/025035 (March 27, 2003), the PCT publication corresponding to US 7,241,502. However, a certified English translation is not being filed at this time because the rejection is substantially untenable in any event for reasons discussed below.

The Obviousness-type Double Patenting Rejection's over the two US patents

The rejection of claims 7-14 for obviousness-type double patenting over claims 26-30 of U.S. Patent No. 7,241,502 and claims 9-14 of U.S. Patent No. 7,291,394 is respectfully traversed.

The cited claims of the '502 patent are directed to a process for preparing a molded article having an optical effect. The cited claims of the '394 patent are directed to a process for preparing a composite material having an optical effect.

Applicants respectfully submit that none of their claims overlap with any claim of '502 or '394 in a manner, which supports an obviousness-type double patenting rejection. The claims of both '502 and '394 are silent regarding a process for preparing an inverse opal structure. They are particularly silent regarding a process in which the core is removed. Neither reference contains any limit of such a removal step or forming any inverse opal structure.

Even if there is some highly generic overlap between the broadest scopes of the two patents and the current claims, such overlap or embracing of subject matter does not support an obviousness-type double patenting rejection. See, e.g., In re Kaplan, 229 USPQ 678, 681 (Fed. Cir. 1986), holding that the existence of claims in two patents/applications which encompass, embrace or dominate the same subject matter does not, per se, give rise to a proper obviousness-type double patenting rejection.

See also General Foods Corp. v. Studiengesellschaft Kohle GmbH, 972 F.2d 1272, 23 USPQ 2d 1839 (Fed. Cir. 1992), where a process for decaffienating coffee did not render obvious (in a double patenting case) a process for recovering caffiene. Similarly, forming an optical effect while using core/shell particles while keeping the particles cannot render obvious, in any sense, preparing a particular optical structure (inverse opal) by removing cores.

Form 1449

Another copy of form 1449, previously submitted March 2006 is attached. It is respectfully requested that the Examiner initial citation 18 to indicate that the Examiner has considered the information.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,
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